

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Nariie KANEKO

Serial No. 09/849,968

Filed May 8, 2001

GOLF SHOES

Confirmation No. 1298

Docket No. 2001_0571A

Group Art Unit 3728

Examiner M. Patterson

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REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents,
Washington, D.C.

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

Sir:

In the Office Action mailed August 1, 2002, the Examiner presented rejections under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 103(a). These rejections are respectfully traversed, and it is respectfully requested that these rejections be withdrawn, for the following reasons.

First, with regard to the rejection under 35 U.S.C. 112, second paragraph, the Examiner stated that, in claims 4 and 11, the open-ended language of "golf shoes comprising" contradicts the limiting language of "bag provided only at said outside portion" and "... having no inflatable sealed bag."

However, it is submitted that the open-ended term "comprising" as used in the present claim is not contradictory to the negative limitations using the terms "only" and "having no ...". Specifically, the claim preambles which recite the term "comprising" are, in fact, open-ended preambles, as the Examiner stated. Accordingly, the claims are to be construed to cover golf shoes that include all of the features specifically recited in the claims, as well as perhaps additional features. The recitation in claim 4 that the "inflatable sealed bag [is] provided only at said outside portion of said forward portion of said sole" does not prevent claim 4 from covering golf shoes that include features other than those specifically recited in the claim. For example, a pair of golf

shoes conforming to all of the features recited in claim 4, but also including shoe laces, would still be encompassed by claim 4. In other words, the negative limitation "only at said outside portion of said forward portion of said sole" relates only to the recited "inflatable sealed bag;" it does not in any way prevent the claim from encompassing golf shoes that also include additional elements not explicitly set forth in the claims other than as explicitly excluded.

Similarly, claim 4 specifies that the "inside portion of said forward portion of said sole [has] no inflatable sealed bag thereat." This limitation does in fact preclude the claim from covering the pair of golf shoes that have one of the shoes including an inflatable sealed bag at the outside portion of the forward portion of the sole, from also having an inflatable sealed bag at the inside portion of the forward portion of the sole, since such is explicitly excluded. There is nothing ambiguous or indefinite about this claim language; the scope of the claim is readily ascertainable from its explicit language.

"In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). MPEP §2173.02."

Also, the Examiner's attention is directed to MPEP §2173.05(i) which states the current view of the court as being that there is nothing inherently ambiguous or uncertain about a negative limitation, so long as the boundaries of the patent protection sought are set forth definitely. This same section of the MPEP cites an exemplary case, *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970), in which a claim including a negative limitation was considered definite because each recited limitation was definite.

The same reasoning applies to the language of claim 11 which includes the open-ended preamble term "comprising", and, in the body of the claim, recites that

"an inflatable sealed bag provided only at said outside portion of said forward portion of said sole of only one of said right foot shoe and said left foot shoe, said inside portion of said forward portion of said sole of said one of said right foot shoe and said left foot

shoe having no inflatable sealed bag thereat, and the other of said right foot shoe and said left foot shoe having no inflatable sealed bag."

This quoted language from the body of claim 11 does exclude a pair of golf shoes having, for example, an inflatable sealed bag provided at both the inside and outside portions of the forward portion of the sole of one of the right and left foot shoes. It also explicitly excludes a pair of shoes having an inflatable sealed bag provided at the outside portion of the forward portion of both of the right foot shoe and the left foot shoe. However, there is nothing unclear or indefinite about this explicit recitation, and it does not conflict with the open-ended term "comprising" in the preamble, for the reasons discussed above. That is, the open-ended term "comprising" in the preamble leaves the claim open to covering a pair of golf shoes that includes elements not specifically recited in the claim, with the exception of the explicit exclusions included in the third paragraph of the body of claim 11 as quoted above.

Thus, it is submitted that the independent claims 4 and 11 clearly define the metes and bounds of the claim scopes, notwithstanding the use of the preamble term "comprising" and the negative limitations included in the bodies of the claims. Therefore, it is submitted that the claims clearly comport with the requirements of 35 U.S.C. 112, second paragraph. If the Examiner persists in this rejection, the Examiner is respectfully requested to cite the legal authority on which the Examiner's position is based.

Next, on pages 2 and 3 of the Office Action, the Examiner rejected claims 4 and 10-12 under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 4,446,634) in view of Wellman (U.S. 4,875,683); and rejected claims 5-9 and 13-17 under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Wellman and Cohen (U.S. 5,133,599). These rejections are respectfully traversed, and it is respectfully requested that these rejections be withdrawn, for the following reasons.

As recognized by the Examiner, the Johnson patent explicitly discloses an inflatable bag at each of the four quadrants of the sole of each of a pair of shoes (see Fig. 6). The Examiner thus cited the Wellman patent for teaching "providing a shoe sole with mean[s] for elevating only the

forefoot lateral (outside) portion of one shoe in a pair of shoes (see column 4, lines 43-46 and column 5, lines 7-22)." From this teaching of Wellman, the Examiner concluded that

"it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the bags except for at the forefoot lateral position (outside) of one shoe to obtain a slant as desired by Wellman in the shoes of Johnson, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art." *In re Karlson*, 136 USPQ 184."

As apparently recognized by the Examiner, however, the *In re Karlson* case stands for the proposition that the omission of an element and its function in a combination is an obvious expedient, but only if the remaining elements perform the same functions as before (i.e. before the omission). This clearly is not the situation at hand.

That is, to eliminate the rear inflatable bags 18A and 18B, as well as the inside front inflatable bag 20B, would not result in the "remaining elements [performing] the same functions as before." Rather, the explicit purpose of the invention disclosed in the Johnson patent is to provide "a means of significantly reducing the shock by absorbing it in the same nature as a shock absorber used on automobiles; that is, in which the shock is absorbed by the movement of fluid" (column 1, lines 22-25 of Johnson). This is accomplished not simply by having bladders independently placed in locations in the sole of the shoe, but rather by providing the bladders 18A, 18B, 20A and 20B with conduits extending therebetween "so that when the heel strikes the ground the weight of the heel portion of the foot of the user forces fluid to flow from the first bladder, through the conduit, to the second bladder under the ball portion. As the foot rolls forward and weight is transferred from the heel to the ball portion, the fluid in the bladder under the ball portion of the foot receives and supports the weight of the user and absorbs shock by transferring fluid from that portion back into the bladder under the heel portion." (See column 1, lines 30-40).

Accordingly, if three of the four inflatable bags illustrated in Fig. 6 were omitted from the Johnson arrangement, essential functions of the Johnson arrangement required to attain the object of the Johnson invention, would be eliminated.

Further, the fact that the modification of the Johnson patent suggested by the Examiner would render the Johnson arrangement inoperable for its intended purpose, means that the Johnson patent in fact teaches away from any such modification. "There is no suggestion to combine ... if a reference teaches away from its combination with another source." *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000). Also see *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Regarding the Examiner's comment at the top of page 4 of the Office Action that "Johnson clearly suggests using the laterally divided bags to control slant of the foot by providing a wedge effect in the shoe (column 4, lines 1-26)," it is noted that this deals only with an increase or decrease in the amount of fluid in the individual bladders, and does not in any way contemplate the omission of any of the bladders. In fact, omission of the bladders would also frustrate the shock absorbing purpose of the Johnson invention.

Next, in the second paragraph on page 4 of the Office Action, the Examiner stated that "in response to Applicants' arguments that Johnson has additional components, it is noted that Applicant has used open language in the claims, i.e. 'comprising' and the fact that Johnson may show additional components does not negate the fact that Johnson does show the elements that are claimed." First, this statement by the Examiner would seem quite contrary to the fact that the Examiner has applied a combination of Johnson in view of Wellman, and taken the position that the teachings of the Wellman patent would have rendered it obvious to omit three of the four bags of the Johnson patent.

Second, as discussed above in connection with the rejection under 35 U.S.C. 112, second paragraph, the explicit limitations of claims 4 and 11 make clear the requirements of these claims. The "comprising" language of the preamble does in fact cause the claims to encompass golf shoes having elements not explicitly recited in the claims, such as the inclusion of shoelaces as

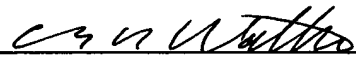
mentioned above, for example. However, the claims are equally clear that they do not encompass golf shoes having inflatable sealed bags at all four quadrants of the shoes as disclosed in the Johnson patent. Thus, for the Examiner to take this position, the explicit limitations, albeit negative limitations, of claims 4 and 11 must be ignored. As explicitly stated in MPEP §2143.03, "to establish *prima facie* obviousness of a claimed invention, all of the claim limitation must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Therefore, it is submitted that the Examiner's statement in the second paragraph on page 4 of the Office Action cannot provide a basis for holding the present claims unpatentable.

For the above reasons, it is respectfully submitted that the independent claims 4 and 11, as well as the dependent claims 5-10 and 12-17 which respectively depend therefrom, are clearly patentable over the prior art as applied by the Examiner. Therefore, it is respectfully requested that the prior art rejections be withdrawn and the application passed to issue.

If, after reviewing this Amendment, the Examiner feels there are any issues remaining which must be resolved before the application can be passed to issue, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

Nariie KANEKO

By: 
Charles R. Watts
Registration No. 33,142
Attorney for Applicant

CRW/jmj
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
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